

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on October 13, 2005, the Examiner objected to claims 35-36, rejected claims 11 and 35-36 under 35 USC §112, first paragraph, provisionally rejected claims 11-15, 21-23, 26-30 and 35-36 under the judicially created doctrine of obviousness-type double patenting, and rejected claims 11-15, 21-23, 26-30 and 35-36 under 35 USC §103(a) as being unpatentable over Jones et al (United States Patent No. 6,172,328, hereinafter “Jones”) or Skonecki (United States Patent No. 5,305,550, hereinafter “Skonecki”) in view of Roulleau (United States Patent No. 5,142,976, hereinafter “Roulleau”). Applicant expresses appreciation for the Examiner’s Interview held via telephone on September 22, 2005, and respectfully provides the following:

Claim Objections

The Examiner objected to claims 35 and 36, indicating that they are internally inconsistent. Applicant respectfully submits that the amendments provided herein overcome the objections made by the Examiner.

Rejections under 35 U.S.C. §112

In the Office Action, the Examiner rejected claims 11 and 35-36 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner specifically indicated:

“The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On page 7, line 21 through page 8, line 2 the specification recited the image may be provided onto an organic product in variety of manners, for example, the images may be printed, painted, sprayed, copied, transferred, etched, embossed, engraved, scratched, stamped, cut, imprinted, scored, carved or otherwise marked into at least a portion of an organic product; however, claims 11 and 35-36 recite each of the group of flowers is free from etching or cut designs. The applicant is

reminded that a negative limitation recited in the present claim, which did not appear in the specification as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 US 112, (*In re Anderson*, 471 F.2d. 1237, 176 USPQ 331 (CCPA 1973)). There is no clear support for this negative limitation.”

Claims 11 and 36 have been cancelled, however in regards to claim 35, Applicant respectfully references MPEP §2173.05(i), which provides:

Any negative limitation or exclusionary proviso must have basis in the original disclosure. **If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.** See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. **Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support.** *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP §2163 - §2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph. (Emphasis added).

Applicant respectfully submits that claim 35 complies with the written description requirement because alternative elements are positively recited in the specification and thus may be explicitly excluded in the claims. As indicated by the Examiner, “On page 7, line 21 through page 8, line 2 the specification recited the image may be provided onto an organic product in variety of manners, for example, the images may be printed, painted, sprayed, copied, transferred, etched, embossed, engraved, scratched, stamped, cut, imprinted, scored, carved or otherwise marked into at least a portion of an organic product”. (Emphasis added) Claim 35 recites “a group of flowers free of an etched or cut image”. (Emphasis added) Because the specification recited images that are “etched” or “cut”, they (the etched or cut images) may be explicitly excluded in the claims in

accordance with MPEP §2173.05(i). Therefore, according to MPEP §2173.05(i), the negative claim limitation “free of an etched or cut image” is properly supported by the specification as originally filed. Accordingly, Applicant respectfully requests that the rejection be withdrawn since claim 35 complies with 35 U.S.C. §112, first paragraph.

Provisional Obviousness-Type Double Patenting Rejection

In the Office Action, the Examiner provisionally rejected claims 11-15, 21-23, 26-30 and 35-36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27 and 37-39 of co-pending application No. 11/061,788 in view of Roulleau. Accordingly, Applicant respectfully submits a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the provisional rejection based on a nonstatutory double patenting ground as co-pending application No. 11/061,788 and the present application are commonly owned. Accordingly, Applicant respectfully requests the provisional rejection be withdrawn.

Rejection under 35 U.S.C. §103

In the Office Action, the Examiner rejected claims 11-15, 21-23, 26-30 and 35-36 under 35 U.S.C. §103(a) as being unpatentable over Jones or Skonecki in view of Roulleau. Applicant respectfully submits that the claim set as provided herein is not made obvious by the cited references for at least the following reasons:

1. The requirement for there being some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings is not satisfied. The standard for a rejection under 35 U.S.C. §103 is set forth in M.P.E.P §706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. **First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the**

art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The claims provided herein specifically recite flowers. In contrast, while Skonecki and Jones teach of flowers, Roulleau teaches of poultry eggs. Eggs and flowers have different contours and properties. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Absent such a showing in the prior art, the Examiner has impermissibly used "hindsight" occasioned by Applicant's teachings to hunt through the prior art for the claimed elements and combine them as claimed. *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Accordingly, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine art that teaches of poultry eggs with art that teaches of flowers. Applicant therefore respectfully submits that a prima facie case of obviousness has not been met that thus the cited references do not make obvious the claims as provided herein.

2. Jones and Roulleau are not properly combinable because Roulleau's intended function is destroyed. Jones specifically teaches to "cut into the surface". (See Abstract line 1; Col. 1, lines 12-15; Col. 3, lines 21-29; Col. 4, lines 21-25.) However, Roulleau's intended function is to provide decorative motifs on uncooked poultry eggs. (See Col. 1, lines 4-5) Cutting into the surface

of an uncooked poultry egg would cause the uncooked poultry egg to crack and/or cause the liquid inside of the shell to escape. Thus, because Roulleau's intended function would be destroyed, Jones and Roulleau are not properly combinable, and therefore Jones and Roulleau do not make obvious the claims as provided herein.

3. The claim set as amended herein is not made obvious by the cited references because Jones teaches away from the claimed invention. Jones specifically teaches to "etch or cut into the surface of the leaf or petal". (See Abstract line 1; Col. 1, lines 12-15; Col. 3, lines 21-29; Col. 4, lines 21-25.) In contrast, independent claim 35 recites "a group of flowers free of an etched or cut image" and independent claim 37 recites "a group of flowers free from cuttings or markings from a laser". Thus, Jones teaches away from the negative limitations recited in the claims. And, such negative limitations are definite according to MPEP § 2173.05(i), which provides:

A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Accordingly, the claim set as amended herein is not made obvious by the cited references because Jones teaches away from the claimed invention.

4. The claim set as amended herein is not made obvious by the cited references because Skonecki teaches away from the claimed invention. Skonecki recites a hand-held applicator to create an image that is not repeatable and further teaches: "Thus, a unique individualized message or drawing can be easily applied to the petal". (See Col. 1, lines 27-35; Col. 1, lines 53-55; Col. 1, lines 62-64; Col 2, lines 1-15; Col. 2, lines 41-44.) In contrast, independent claims 35 and 37 recite "a

repeatable, identical, pad-printed image provided on each of the flowers in the group of flowers".

Therefore the independent claims as amended herein are not made obvious by the cited references because Skonecki teaches away from the claims.

5. The claim set as amended herein is not made obvious by the cited references because Jones teaches away from Skonecki. Jones specifically teaches to "etch or cut into the surface of the leaf or petal". (See Abstract line 1; Col. 1, lines 12-15; Col. 3, lines 21-29; Col. 4, lines 21-25.) In contrast, Skonecki teaches "preventing damage to the petal." (See Col. 2, lines 17-18) Thus, the claim set as amended herein is not made obvious by the cited references because Jones teaches away from Skonecki.

Thus, for at least the reasons provided above, Applicant respectfully submits that the references cited herein do not make obvious the independent claims. In addition, dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that the cited references do not make obvious the claim set provided herein.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, or if the Examiner would like to suggest amended claim language, the Examiner is invited to call the undersigned.

DATED this 29 day of November, 2005.

Respectfully submitted,

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